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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,854	02/07/2005	Soon Keun Lee	930086-2007	4420

7590 02/11/2009  
Ronald R Santucci  
Frommer Lawrence & Haug  
745 Fifth Avenue  
New York, NY 10151

EXAMINER
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WINSTON, RANDALL O

ART UNIT	PAPER NUMBER
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1655

MAIL DATE	DELIVERY MODE
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02/11/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,854	<b>Applicant(s)</b> LEE ET AL.	
	<b>Examiner</b> Randall Winston	<b>Art Unit</b> 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) 5, 13 and 14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 15-16 and 19 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/24/2008 has been entered.

Examiner acknowledges that claims 5 and 13-14 are withdrawn from consideration.

Claims 15-22 have been examined on the merits.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Park (Derwent-Acc-No 2001-576146 or KR 2001028519).

Applicant claims a method for treating acne comprising administering to a subject in need of such treatment a topical formulation which comprises an extract obtained from *Canavalia gladiata*.

Park anticipates the claimed invention because Park teaches a method for treating acne (i.e. an antimicrobial activity against acne pathogen etc.) comprising administering to a subject in need of such treatment a topical formulation which comprises an extract obtained from *Canavalia gladiata* (see, e.g. abstract). Therefore, the reference is deemed to anticipate the claimed invention.

Claims 15 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Abe (Derwent-Acc-No 1995-101781 or JP 07025746 A).

Applicant claims a method for treating acne comprising administering to a subject in need of such treatment a topical formulation which comprises an extract obtained from *Biota orientalis*.

Abe anticipates the claimed invention because Abe teaches a method comprising administering to a subject in need of such treatment a topical formulation which comprises an extract obtained from *Biota orientalis* to treat skin disorders. (see, e.g. abstract). Moreover, when Abe's same extract obtained from *Biota orientalis* as the claimed invention's same extract obtained from *Biota orientalis* is topically applied in any and/or all effective amounts to a subject's skin to treat skin disorders, Abe's same extract obtained from *Biota orientalis* as the claimed invention would also inherently have the same claimed functional effect as the claimed invention when applied to the skin (i.e. the functional effect treating acne and/or an antimicrobial activity against acne pathogen etc). Therefore, the reference is deemed to anticipate the claimed invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-16, 19 and 22 are rejected under 35 US 103(a) as being unpatentable over Park.

Applicant claims a method for treating acne comprising administering to a subject in need of such treatment a topical formulation which comprises an extract obtained from *Canavalia gladiata* in various amounts and forms.

The cited reference is relied upon for the reasons discussed above. Park does not expressly the claimed composition administered in all the claimed amounts and claimed forms. However, based upon the overall beneficial teachings provided by Park, the result-effective adjustment of conventional working conditions therein (e.g. determining suitable amounts/ranges of each active ingredient within the claimed composition and/or claimed forms), is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Accordingly, the invention as a whole is prima facie obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

Claims 15-16, 19 and 22 are rejected under 35 US 103(a) as being unpatentable over Abe.

Applicant claims a method for treating acne comprising administering to a subject in need of such treatment a topical formulation which comprises an extract obtained from *Biota orientalis* in various amounts and forms.

The cited reference is relied upon for the reasons discussed above. Abe does not expressly the claimed composition administered in all the claimed amounts and claimed forms. However, based upon the overall beneficial teachings provided by Abe, the result-effective adjustment of conventional working conditions therein (e.g. determining suitable amounts/ranges of each active ingredient within the claimed composition and/or claimed forms), is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Accordingly, the invention as a whole is prima facie obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Winston whose telephone number is 571-272-0972. The examiner can normally be reached on 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1655

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RW

/Christopher R. Tate/  
Primary Examiner, Art Unit 1655